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EXAMINER

MORGAN, ROBERT W

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* DAVID W. CUNNINGHAM,
9 JOHN M. HARDEN,
10 WILLIAM N. ENGLE, and
11 CHARLES W. REUBEN
12

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14 Appeal 2009-005222
15 Application 10/098,700
16 Technology Center 3600
17

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19 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
20 ANTON W. FETTING, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON REQUEST FOR REHEARING¹
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24
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¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 The Appellants filed a REQUEST FOR RECONSIDERATION on
2 August 23, 2010. The Examiner rejected claims 15-19, 54-55, and 64-72
3 under 35 U.S.C § 102(e) as anticipated by Deaton and rejected claims 15-19,
4 54-55, and 64-72 provisionally under the doctrine of obviousness-type
5 double patenting. We reversed the anticipation rejections and affirmed
6 obviousness-type double patenting rejections in our June 21, 2010 Decision.
7 The Appellants seek reconsideration of the decision to affirm the
8 obviousness-type double patenting rejections.

9 We DENY the REQUEST FOR REHEARING.

10 ISSUES

11 The issue pertinent to this request is whether the Appellants have
12 sustained their burden of showing that we misapprehended the art or the
13 claims and thus erred in sustaining the obviousness-type double patenting
14 rejections of claims. 37 C.F.R. 41.52(a)(1). The pertinent issue turns on
15 whether we improperly used an obviousness analysis instead of the required
16 non-statutory obviousness-type double patenting analysis.

17 ANALYSIS

18 We found in our decision that claims.

19 The Examiner erred in rejecting claims 15-19, 54-55, and 64-72
20 under 35 U.S.C. § 102(e) as being anticipated by Deaton.

21 The Examiner did not err in rejecting claims 15-19, 54-55, and
22 64-72 under the doctrine of obviousness-type double patenting.

23 Decision 12.

24 The Appellants first contend that we improperly applied an obviousness
25 analysis based on 35 U.S.C. § 103(a) in our analysis of the non-statutory

1 obviousness-type double patenting rejection. Request 1-2. The Appellants
2 point to the panel's use of the word "patent" rather than "claim" in the
3 analysis of the pertinence of the prior art as a primary reason for the
4 Appellants' contention. However, the Appellants' do *not* contend that the
5 panel's analysis earlier in the Decision was *not* between the claims in the
6 instant application and the corresponding claims in the '449 patent, which is
7 the relevant inquiry relative to the Appellants' contentions.

8 We begin by pointing out that the only limitation in contention in the
9 obviousness-type double patenting rejection is limitation [6] of claims 15
10 and 66 and as applied to claims 16 and 67. Since the Appellants have not
11 contested the remaining limitations (App. Br. 14 and Request 4), we have
12 taken this as an indication that the Appellants agree that the remaining
13 limitations between claim 5 of the '449 patent and claims 15 and 66 are
14 identical. As such, our analysis is based on whether limitation [6] is an
15 obvious variant. "[I]f the scope of the application and the patent claims is
16 not identical, the court must ask whether the former defines merely an
17 obvious variation of the latter." *In re Berg*, 140 F.3d 1428, 1432 (Fed. Cir.
18 1998). "A later patent claim is not patentably distinct from an earlier patent
19 claim if the later claim is obvious over, or anticipated by, the earlier claim.
20 *In re Longi*, 759 F.2d at 896 (affirming a holding of obviousness-type
21 double patenting because the claims at issue were obvious over claims in
22 four prior art patents)." *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955,
23 968 (Fed. Cir. 2001).

24 In our decision we found that limitation [6] is obvious in view of the
25 cited prior art since Deaton describes the feature of limitation [6]. The
26 Appellants argue that our finding of motivation and use of prior art are used

1 for an obviousness determination under 35 U.S.C. § 103(a) and not for non-
2 statutory double patenting. “However, a double patenting of the
3 obviousness type rejection is ‘analogous to [a failure to meet] the non-
4 obviousness requirement of 35 U.S.C. § 103,’ except that the patent
5 principally underlying the double patenting rejection is not considered prior
6 art.” *In re Longi*, 759 F.2d 887, 892 (C.A.Fed.,1985), *In re Braithwaite*, 379
7 F.2d 594, 600 (1967). As such, in our decision found that claims 6 and 66 of
8 the claimed invention are obvious variants of claim 5 of ‘449 in view of
9 Deaton. As such, our application of an obviousness analysis that parallels
10 that of a 35 U.S.C. § 103(a) analysis, where we determined that the claims of
11 the present invention are obvious variants of ‘449, is proper. Thus, we find
12 this argument unpersuasive as to error on our part.

13 The Appellants additionally contend that we incorrectly construed the
14 term “varying the value of at least some of the media such that the value of
15 the media varies according to selected conditions.” Request 4. We begin by
16 pointing out that in our decision we applied a construction of the term that
17 was provided by the Appellants. Decision 10-11 and Reply Br. 3. In the
18 Reply Brief, the Appellants provided the claim construction for this term to
19 encompass bringing about a change in the value of the media according to
20 certain conditions. Reply Br. 4.

21 Our claim construction of this term encompasses any type of variation in
22 the value of the media. Decision 10. This construction is both consistent
23 with the Specification and consistent with the construction provided by the
24 Appellants. The Appellants now argue that the proper construction of this
25 term requires the media to be issued and thereafter be subjected to variations
26 in value in order to be consistent with the claim as a whole. Request 4-5.

However, there is nothing explicit or implicit in the claim language that requires that the method steps are performed in a specific order. The distribution step of limitation [7] does not require the varying the value step of limitation [6] to be performed before the distribution. Since we do not find a requirement in the claim language that the method steps are performed in a specific order, our claim construction is consistent with the claim as a whole. As such, the Appellants' argument is not found persuasive as to error on our part.

For the above reasons we are not convinced of reversible error in our decision. Accordingly, the Appellants' request for rehearing is denied,

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING.
- We DENY the request that we reverse the Examiner as to claims 15-19, 54-55, and 64-72.
 - The rejection of claims 15-19, 54-55, and 64-72 under 35 U.S.C. § 102(e) as being anticipated by Deaton remains not sustained.
 - The rejection of claims 15-19, 54-55, and 64-72 under the doctrine of obviousness-type double patenting remains sustained.

REHEARING DENIED

Appeal 2009-005222
Application 10/098,700

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